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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/010,317 01/21/98 HOOK

M TANKE 189

EXAMINER

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HM22/0818

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ART UNIT	PAPER NUMBER
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1645

DATE MAILED:

08/18/00

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No. 09/010,317	Applicant(s) Hook et al
Examiner LI Lee	Group Art Unit 1645



Responsive to communication(s) filed on Jun 26, 2000

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claim

Claim(s) 33-35 and 37 is/are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 33-35 and 37 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

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### **DETAILED ACTION**

1. Applicant's amendment filed on Jun 26, 2000 (Paper Number 19) has been received and entered. Claim 33 has been amended, consequently claims 33-35 and 37 are pending in the instant application.
2. The rejection of claims 33-35 and 37 under 35 U.S.C. 102(e) as being anticipated by Burnham et al (US 5,955,078, Sep 21, 1999) is maintained for reasons made of record in Paper No 15, mailed 2/25/00.

Applicants' amendments are insufficient to obviate this rejection since the claims still read on a method of generating an antibody that binds to a fibronectin binding domain of a fibronectin binding protein and inhibits said fibronectin binding protein to fibronectin. The claims are not limited to the specific sequences recited because of the phrase "consists essentially of" which is considered open language. The specification does not include a clear indication of the basic and novel characteristics. The immunogen of the peptide of SEQ ID NOs:60, 61, 103, 104, 86, and 87 used to generate the claimed antibody in the instant application has an 100 % identical sequence to the peptides of Burnham et al of SEQ ID Nos: 6-8, 15, 13, and 10, therefore, the method of Burnham et al reads on the claims because of the breadth of the claims.

3. Claims 33-35 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Hook et al (EP 0294349-A, 12/07/88).

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Hook et al teach a method of generating an antibody that binds to a fibronectin binding domain of a fibronectin binding protein and inhibits said fibronectin binding protein to fibronectin (page 8, lines 4-6). The antibody of Hook was generated using an immunogen which is 100% identical to the immunogen used in the instant application, a peptide of SEQ ID NO:3. Since the method of Hook et al has same steps as the claimed method (e.g., administering to an animal a peptide), uses same immunogen (e.g., the peptide having the sequence of SEQ ID NO:3) and will generate same antibody as the claimed antibody (e.g., antibody that binds to a fibronectin binding domain of a fibronectin binding protein and inhibits said fibronectin binding protein to fibronectin), Hook et al meet all the limitations of the claims.

### *Conclusion*

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Status of Claims***

5. No claims are allowed. All claims stand rejected.

Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1645 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1600 is (703) 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Li Lee whose telephone number is (703) 308-8891. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached at (703) 308-3909.

Li Lee  
August 16, 2000

*R. F. Smith*  
LYNETTE R. F. SMITH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600